

Remarks

Applicants have cancelled claims 2-5 without prejudice or disclaimer. New claims 6-19 have been added in order to claim embodiments of the subject matter of the provisionally-elected group. New claims 6-19 find support throughout the specification and claims as originally filed, and thus no new matter has been added. In particular, support for new claims 6-19 can be found in the specification, for example, at page 160, paragraph 399; at page 174, paragraphs 442-443; at Example 20, page 364, paragraph 956 to page 369, paragraph 970; and at Example 24, page 382, paragraph 986 to page 383, paragraph 988.

Original claim 1 and new claims 6-19, are pending.

The Restriction Requirement

Pursuant to Paper No. 2, mailed December 19, 2003, the Examiner has required an election under 35 U.S.C. § 121 of one of Groups I-IV. The Examiner contends that the inventions are distinct, each from the other.

In response, Applicants submit that the subject matter of new claims 6-19, while fully supported by the specification as filed, does not fall entirely within the scope of the Groups defined by the Examiner in the Office Action. Under M.P.E.P. § 818.02(a), an election may be made by the presentation of original claims to another invention. Accordingly, pursuant to M.P.E.P. § 818.02(a), Applicants provisionally elect, *with traverse*, the invention of new claims 6-19, drawn to, *inter alia*, methods of treating inflammation by administering to a patient in need thereof a therapeutically effective amount of a polypeptide comprising amino acids 69-208 of SEQ ID NO:2, including, but not limited to, a polypeptide comprising amino acids 63-208 of SEQ ID NO:2. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final.

With respect to the Examiner's division of the invention into four groups and the reasons stated therefor, Applicants respectfully disagree and traverse.

Applicants point out that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the

search and examination of these groups would entail a “serious burden.” *See* M.P.E.P. § 803. In the present situation, although the Examiner has argued that Groups I-IV are separately classified or constitute divergent subject matter, Applicants nonetheless submit that a search of the claims of any of the groups would also provide useful information for the claims of the other groups. In particular, Applicants note that each of the claimed methods involve using a polypeptide with a common sequence. For example, in many if not most publications disclosing a protein disclose not only the sequence of the proteins but also methods of making and using the protein. Thus, since the searches for proteins and methods of making and using the protein commonly overlap, the combined search and examination of such compositions and methods using the same would not entail a serious burden, even assuming *arguendo* that all of the searches were not coextensive.

Accordingly, in view of M.P.E.P. § 803, the claims of all of Groups I-IV and new claims 6-19 should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

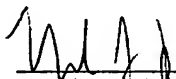
Conclusion

Entry of the above amendment is respectfully solicited. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Respectfully submitted,

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